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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,908	07/16/2001	Hiromichi Komori	XA-9517	3669

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MILES & STOCKBRIDGE PC
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EXAMINER
DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
3679	

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/904,908	KOMORI ET AL.	
	Examiner	Art Unit	
	Aaron M Dunwoody	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2/28/03, 3/13/03* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,5,6 and 8-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2,5,6,8,15 and 22* is/are allowed.

6)☒ Claim(s) *9-11,13,14,16,17,19-21 and 23* is/are rejected.

7)☒ Claim(s) *12 and 18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the method of manufacturing a coupling member, only structural limitations are cited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 13, 14, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5916026, Sadakata.

In regards to claim 10, Sadakata discloses an elastic shaft coupling (101a) comprising a joint member (104) formed with a hole; a hollow shaft member (102a) received in the joint member; an elastic member (111) interposed radially between the joint member and the hollow shaft member to flex and deform upon relative rotation

between the joint member and the hollow shaft member; stopper portions provided, respectively, on the joint member and the hollow shaft member to restrict the relative rotation therebetween within a predetermined amount; and the stopper portions provided on the joint member each including a pair of stopper faces spaced from each other in a peripheral direction to form a gap therebetween, the stopper portions provided on the hollow shaft member each being radially outwardly projected into the gap formed between the stopper faces of the corresponding stopper portion provided on the joint member, the stopper portions on the hollow shaft member being formed by flaring an end of the hollow shaft member to be projected radially outwardly.

The method of forming, in particular, the stopper portions on the hollow shaft member being formed by flaring an end of the hollow shaft member to be projected radially outwardly, the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

In regards to claims 13 and 19, Sadakata discloses the outer diameter of each of the stopper portion on the hollow shaft member being formed smaller than the outer diameter of the corresponding stopper portion on the joint member.

In regards to claims 14 and 20, Sadakata discloses the radially outermost points of contact of each stopper portion on the hollow shaft member with the corresponding stopper faces on the joint member are disposed inwardly from respective centers of the stopper faces along a radial direction.

In regards to claim 17, Sadakata discloses an elastic shaft coupling comprising a joint member formed with a hole; a hollow shaft member received in the joint member,

the hollow shaft member having an original wall thickness an elastic member interposed radially between the joint member and the hollow shaft member to flex and deform upon relative rotation between the joint member and the hollow shaft member; stopper portions provided, respectively, on the joint member and the hollow shaft member to restrict the relative rotation therebetween within a predetermined amount; and the stopper portions provided on the joint member each including a pair of stopper faces spaced from each other in a peripheral direction to form a gap therebetween, the stopper portions provided on the hollow shaft member each being radially outwardly projected into the gap formed between the stopper faces of the corresponding stopper portion provided on the joint member, the stopper portions on the hollow shaft member being formed by flaring an end of the hollow shaft member while applying axial pressure on the end to produce a root portion of the stopper portion on the hollow shaft member having an thickness (tl) greater than the original wall thickness (t2) of the hollow shaft member.

A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976). Therefore, the stopper

portions on the hollow shaft member being formed by flaring an end of the hollow shaft member while applying axial pressure on the end to produce a root portion of the stopper portion on the hollow shaft member having an thickness (tl) greater than the original wall thickness (t2) of the hollow shaft member is given little patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadakata.

In regards to claim 11 and 21, Sadakata discloses the claimed invention except for the hollow shaft member being a steel pipe of a low carbon steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the hollow shaft member from a steel pipe of a low carbon steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 2, 5, 6, 8, 15 and 22 are allowed.

Claims 12 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9, 16 and 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 2, 5 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it illustrates the current state of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M Dunwoody whose telephone number is (703) 306-3436. The examiner can normally be reached on Monday - Friday between 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

.amd
June 2, 2003

Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3670